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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 *Ex parte* DOUGLAS B. WILSON
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13 Appeal 2009-001868
14 Application 10/727,306
15 Technology Center 3600
16

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18 Oral Hearing Held: August 13, 2009
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21 Before LINDA E. HORNER, JOHN C. KERINS and
22 MICHAEL W. O'NEILL, *Administrative Patent Judges.*
23

24
25 ON BEHALF OF THE APPELLANT:
26

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33 The above-entitled matter came on for hearing on Thursday, August 13,
34 2009, commencing at 1:31 p.m., at the U.S. Patent and Trademark Office,
35 600 Dulany Street, Alexandria, Virginia, before Dawn A. Brown, Notary
36 Public.

PROCEEDINGS

2

3 THE USHER: Calendar number 59 and Calendar Number 60,
4 Mr. Kennard.

5 JUDGE HORNER: Good afternoon, Mr. Kennard.

6 MR. KENNARD: Good afternoon. How are you?

7 JUDGE HORNER: Do you happen to have a business card you can
8 provide to the court reporter?

9 MR. KENNARD: I do, Your Honor.

10 COURT REPORTER: Thank you, sir.

11 MR. KENNARD: I'd like to introduce Doug Wilson, who is the
12 inventor, and his wife Pamela Wilson.

13 JUDGE HORNER: Thank you.

14 MR. KENNARD: For ease and convenience, I've put together -- these
15 are just the pertinent parts of the record and talking about the references at
16 issue. And I've also provided an even shorter-hand version, which has
17 Mr. Wilson's invention of the two patents at issue and also the references, how
18 they were described by the Examiner in applying to portions. I've only used
19 one of them since the three anticipation rejections are the same for both the
20 '306 and the '821.

21 JUDGE HORNER: And this is information that is in the record?

22 MR. KENNARD: This is all in the record, yes.

23 JUDGE HORNER: Okay.

24 MR. KENNARD: It is just the -- and I will go through -- if you look at
25 it, Your Honor, it is just Mr. Wilson's figure 3 and 4 and the claim 20, which is

1 the only independent claim. The second page is claim 14, the only
2 independent claim.

3 Next is the first reference, Van Arsdel, and this is from the record from
4 the Examiner where he indicated the first and second section. The Anson
5 reference, the same type of information, and followed by the Laubach.

6 JUDGE HORNER: Since the art is the same in both cases, what we
7 thought we would do is have you -- if you'd like, you can present sort of both
8 cases together in 40 minutes instead of doing one case in 20 and then the other.
9 Is that okay with you?

10 MR. KENNARD: I was hoping that would be the case.

11 JUDGE HORNER: That is fine. And then we'll put a transcript in each
12 record of the same transcript.

13 MR. KENNARD: Thank you very, very much.

14 To get started, I would like to -- sometimes a visual is better than many
15 things. This is what we're talking about with Mr. Wilson's invention. And we
16 put it on the steering wheel but it would be secured.

17 If you look at the first page of -- the PowerPoint is very easy -- where it
18 shows figures 3 and 4, when this is fixed and you're driving, your hand would
19 rest on here. It rests and is supported. And that, as we talk about, is a first
20 section that attaches. The second section, which extends from the first section
21 at an angle to the plane, your hand rests on here.

22 Well, what happens, as we all do, when we have an emergency
23 situation, somebody stops forward, which is the invention we're looking at.
24 What can you do with this? You grab it and look exactly what it does.

25 The support that it had, you've gone beyond deforming pressure and

1 you're able to grab the wheel, to securely grab it, so you can properly operate
2 the vehicle.

3 And you're sitting there again as you're riding along, hand rests, it
4 provides the medical benefits, which that is not part of this, but so you don't
5 get fatigued. But something happens, once again, you can grab it.

6 And that is why sometimes -- if I may approach?

7 JUDGE HORNER: Yes.

8 MR. KENNARD: So you don't think it is lawyers doing this. If
9 someone would grab that, you can see if your hand is resting and you pull, it
10 will actually -- you can rest it there.

11 JUDGE HORNER: Okay.

12 MR. KENNARD: The two cases that you have before you, there is
13 common interest as Your Honor did provide and it has to do with the
14 anticipation rejection under 102.

15 Under 102, the standard is going to be one in which a single reference
16 must add each and every element in the same way for there to be an
17 anticipation of rejection. That is common to both cases -- I'll call it the '821
18 and the '306, if you don't mind the shorthand.

19 The second issue goes to the '306 case, which looking at the claim 14, is
20 where we have rigid, semi-rigid, deformable and inflexible in that claim.

21 JUDGE O'NEILL: Counsel, it would probably be easier for us if you
22 would refer to the two cases, not by their serial numbers, because we'll start to
23 get confused, but maybe by -- you've argued them as groups, so you have
24 claim 20 in one case and then claim 14 in the other case. And that would help
25 with how we kind of see them.

1 MR. KENNARD: Okay.

2 JUDGE HORNER: We use appeal numbers rather than the serial
3 numbers up here, so we don't always reference them by their application
4 numbers.

5 MR. KENNARD: You want me to use the appeal number? I will do
6 that.

7 JUDGE HORNER: That would be fine.

8 JUDGE O'NEILL: If you can.

9 MR. KENNARD: If I say the 0506 and the other is the 1868.

10 The second one, the 1868 case is one in which there is the second issue,
11 and that is the indefinite issue of the use of the terms rigid, flexible, semi-rigid
12 and deformable.

13 If you notice the filing dates of these two cases, they are within a couple
14 of weeks. The first was filed, and that was the 5608 case. And then
15 Mr. Wilson recognizing that there may be a new-matter issue of adding the
16 information of rigid, semi-rigid, flexible and deformable, those defining terms
17 to the second section, the second CIP was added. So he wasn't trying to argue
18 it. He said fine. He did that and that was provided in the --

19 JUDGE HORNER: You're referencing rigid, semi-rigid or flexible and
20 deformable, but the claim says nondeformable.

21 MR. KENNARD: That was corrected in the course of the --

22 JUDGE HORNER: Okay.

23 MR. KENNARD: -- in the prosecution.

24 JUDGE HORNER: Okay.

25 MR. KENNARD: The -- and when that change was made, it was not

1 to add new matter; it was for the purpose of making sure there was a clarity of
2 the issue with respect to the first and second section and what applied to the
3 second section.

4 JUDGE HORNER: The claim's appendix reads -- I think it is the old
5 version of the claim. The claim's appendix to your brief reads nondeformable,
6 so we were getting a little confused.

7 MR. KENNARD: Okay.

8 JUDGE O'NEILL: So it actually reads rigid, semi-rigid, flexible or
9 deformable?

10 MR. KENNARD: Let me get the change of the claim. It was in -- I will
11 find it, Your Honor. I will find what it is. It was cited in the 30 -- in the 16 --
12 1568 case.

13 JUDGE KERINS: 1868?

14 MR. KENNARD: 1868. I am sorry.

15 JUDGE KERINS: That is fine. I just want to make sure we have the
16 right one.

17 JUDGE O'NEILL: What is your serial number for your 1868 case?

18 MR. KENNARD: That is '306.

19 JUDGE HORNER: 10/727,306.

20 MR. KENNARD: When we cited --

21 JUDGE O'NEILL: When did you add that correction, do you know?

22 MR. KENNARD: That is what I'm getting at, Your Honor.

23 JUDGE O'NEILL: I mean, did you do it in an amendment of some sort?

24 MR. KENNARD: It was during the prosecution in an amendment.

25 JUDGE HORNER: Can you remember when?

1 MR. KENNARD: I'm looking at the response.

2 JUDGE O'NEILL: Give me a general month, year.

3 MR. KENNARD: Yes. I'm looking. It has nondeformable in the
4 response dated June 12, 2006, that we filed.

5 JUDGE O'NEILL: Unfortunately, that was nonresponsive. Why was
6 that held nonresponsive? So that didn't go in. Wait a second. No, it is --
7 something was nonresponsive. Did they put that in?

8 JUDGE KERINS: Counsel, even in that paper, it continues to use the
9 word non-deformable as well as an amendment after final that was filed after
10 that.

11 JUDGE O'NEILL: So it has not been entered based on our electronic
12 records. Even the amendment of January 2006 it was never changed. You
13 added peripheral to the first section.

14 JUDGE HORNER: We were having a little trouble figuring out how
15 the second section could be made of a non-deformable material but then later
16 the claim requires it to deform, and if indeed you meant to say deformable
17 here, that would make that issue go away and be clearer to us as to how -- it
18 would make more sense if it were a deformable material.

19 JUDGE KERINS: That wasn't the Examiner's specific 112 --

20 MR. KENNARD: No, it wasn't.

21 JUDGE KERINS: -- objection. But in our review of the case, we
22 picked up on that and we're trying to determine if that raised a separate 112
23 issue.

24 MR. KENNARD: Right.

25 JUDGE O'NEILL: I have nothing in the record here of that ever

1 being changed.

2 MR. KENNARD: I will find it. If I could complete the argument and
3 then I will find it.

4 JUDGE HORNER: Absolutely.

5 MR. KENNARD: As to the issue -- with respect to the issue -- the
6 indefiniteness matter, it was cited by the Examiner that the terms that were
7 used were indefinite, and he cited a number of references, case citations, the
8 main one being Phillips, and we changed our position along the way. And
9 we'll get to that. But I just want to frame the two issues that are before you.

10 I would like to address the anticipation rejection first. As I
11 demonstrated and what the current form of claim 20 -- this is going to be in the
12 first application, which is 5608, if I'm correct.

13 JUDGE HORNER: That is right.

14 MR. KENNARD: And 5608, it includes the first section, which again,
15 as we've shown here, is attached to the steering wheel.

16 The second section, which we talk about, is going to be extending at an
17 angle from the plane and as -- during prosecution it was raised the issue about
18 the limitations with respect to the second claim. That precipitated the
19 changing of the claim to provide for the issue of deforming pressure. When
20 deforming pressure is provided, that would then cause it to form out of
21 interference with holding the steering wheel.

22 This action was shown to the Examiner during prosecution, and when
23 we looked at the references, the three that you have, we looked at those of not
24 providing what was under the standard of section 102 for anticipation.

25 If we look first at the Van Arsdel reference, and if you look, I think it is

1 going to be on page 3 -- page 4 rather of the little shorthand version, the
2 Examiner cited, if you see the first arrow going across, where the element
3 which is shown at 2 where it contacts the wheel, he has shown as being the
4 first section, what he has at 4.

5 I hope you can see it.

6 JUDGE HORNER: Uh-huh.

7 MR. KENNARD: That is what he says the first section. Then the
8 second section he indicates is this second -- item 2, which he said has a
9 concave surface of which a palm rests. The operation as articulated in the
10 briefing, once that is put on, if you look at it in figure 6, it is in -- we feel that
11 is in the plane of the wheel because it is going across the wheel on the interior
12 portion.

13 And the Examiner says the little tip, if you look where 4 goes up, he
14 says that is where it is -- it provides a part of the second section that is -- that
15 extends from the plane out -- you know, out of that plane. But that is not
16 providing, what we say in the second section, support.

17 Further, if you look at the way this is constructed, when they screw, if
18 you see screw 14, they tighten this down onto the wheel and it doesn't move.
19 And the Examiner argued that, well, you know, it can be moved, so that makes
20 it deformable. To do that, you have to unscrew it. That is removing. That is
21 not deforming. That is a physical act you have to take to unscrew it and move
22 it.

23 And the only safe way you could do that -- I guess you could try --
24 people drive with cell phones these days. I guess you could try to unscrew it
25 while you're driving, but I think that would be outside of what this is talking

1 about doing. The movement of that would be something that is necessary to
2 move it from one place to another, but that is an act of moving it, removing it
3 and putting it in another location.

4 And so when we talk about -- again, here we are. And we try to use
5 precise language and say when you have it here, it is resting. But when you
6 have to put more than deforming pressure, it is going to bend that around so it
7 is going to be safely used in those type of situations.

8 The second reference is Anson, if you turn to next page. This is a little
9 bit different, but as we argued in the Brief, it doesn't provide any type of
10 support in and of itself. This is something -- if this were the wheel, we'll move
11 it around here since we have to use it. It would be dangling down here. It
12 dangles down and someone holds it supposedly to hold the wheel.

13 It states very clearly and unequivocal that the resting takes place
14 because your hands are -- and I don't want to sit down in front of Your
15 Honors -- but it is -- it says you put your hands -- tells you you put your hands
16 in your lap and that provides the resting, and you hold on to this dongle.

17 That dongle then is -- I don't know if I want to use it or not, but the
18 dongle is supposedly there, but it doesn't provide support. It says clearly it is
19 the lap that provides the resting portion for your hands.

20 JUDGE O'NEILL: What about your fingers?

21 MR. KENNARD: Well, I think you'd be doing just the opposite. If
22 you're looking to relax your hands and wrists, grabbing and holding is not
23 relaxing.

24 JUDGE O'NEILL: Well, your claim just requires a second section for
25 supporting at least a portion of the vehicle operator's body. So it could be a

1 finger, could it not?

2 MR. KENNARD: Supporting a finger?

3 JUDGE O'NEILL: Yes. It is a part of a vehicle operator's body, isn't it?

4 MR. KENNARD: I'm saying you have to grasp though. This is
5 supporting; this is grasping.

6 JUDGE O'NEILL: Well, it looks to me that the wheel attachment is
7 kind of an oblong, maybe egg shape, and it is made out of a rubber-type
8 material. That the friction along with that oblong egg shape would allow you
9 just to have your fingers hold on.

10 I mean, there is some friction going on to just hold it in place just as
11 similar as your wheel is of some sort of frictional material. If that was not a
12 frictional material, wouldn't your hand just slide right off of it?

13 MR. KENNARD: Here? If it is here?

14 JUDGE O'NEILL: Wouldn't your hand, if that was made of a
15 frictionless material, wouldn't your hand just slide right off of it?

16 MR. KENNARD: Like this?

17 JUDGE O'NEILL: Yes. It wouldn't maintain some support.

18 MR. KENNARD: It wouldn't maintain support then.

19 JUDGE O'NEILL: Right.

20 MR. KENNARD: If this --

21 JUDGE O'NEILL: I'm saying basically that the materials disclosed in
22 Anson and the material that appears to be what you're invention is made of are
23 pretty much similar and that there is some frictional force that is assisting in
24 the support. It is not just the structure itself.

1 MR. KENNARD: There is support provided. It can be something on
2 here or it could be integral with the wheel.

3 JUDGE O'NEILL: But I'm just having difficulty seeing why the Anson
4 reference doesn't in some shape, way or form because of its shape and because
5 of its materials that are being used to fabricate it that it doesn't provide some
6 support to some body part.

7 MR. KENNARD: In my reading, Your Honor, they talk about what is
8 provided, and they talk about the lap, and I'm reading what the spec said and
9 this is what the disclosure of Anson talked about. And I cited to it within the
10 Appeal Brief that what -- the resting part is caused by the lap.

11 JUDGE O'NEILL: Maybe you'd like to move now into what really
12 seems to be the issue between yourself and the Examiner -- not what is
13 expressly or explicitly disclosed in the reference, but what is inherently
14 disclosed in the reference.

15 And maybe this is now getting into that portion of what is inherently
16 disclosed in the reference and what is your burden to show if the Examiner
17 says that something is inherently disclosed. What is your burden and have you
18 met that burden?

19 MR. KENNARD: Inherency is that if there is a reference and there is --
20 if inherently that would carry it out as one of skill in the art would understand,
21 then that cannot be a distinguishing feature for purposes of patentability.

22 I think the inherent -- in looking at what you're mentioning. If, in fact,
23 the inherent nature -- this is the dongle -- I'll just call it the dongle -- in Anson
24 were to be the resting area and resting of hands, you would not -- let's move it

1 to the top. We'll move it to the top. And we're holding up there. Would it be
2 causing a situation where you have the resting of the hands?

3 And the resting as they indicate to me in order to, one, at the base -- and
4 I don't think it is inherently resting in this case of Anson because you want to
5 hold this thing to hold the wheel. You're holding this. You're resting your
6 arms but they're saying you're going to control the car with the dongle.

7 Here, when we're holding this we're resting our wrist, but we're -- we're
8 resting our wrists but we're holding on with your fingers.

9 JUDGE KERINS: Counsel, in your invention when you're resting your
10 wrists there, surely you're going to have some movement of the wheel back
11 and forth that won't require you to actually deform and grip the wheel; isn't
12 that correct?

13 MR. KENNARD: That is correct. But you are resting -- it is the not the
14 lack that is causing it; it is the unit. The second section is causing the resting
15 effect to take place.

16 If you look at the dongle, this dongle is one you have to hold and you're
17 sitting like this, and I'm trying not to be informal. You're resting and you're
18 holding the dongle supposedly to control the car.

19 The lap itself is the one that is providing -- if we were trying to equate
20 the two, it is not the device that is doing it; it is the lap that is causing what is
21 happening in the second section, not the dongle.

22 JUDGE KERINS: Counsel, we also in the anticipation arena where I
23 believe the claim language we're discussing here is pretty much functional
24 language, isn't it true that the prior art only needs to be capable of performing
25 that function?

1 MR. KENNARD: And that is why I say -- and take the capability issue.
2 If, in fact, you move -- and that is why I said let's move the dongle up top.
3 And is it capable of doing it where it is going to be independent of the lap?
4 Then you have nothing -- there is nothing to rest. From the use of that, it is not
5 inherent that that is going to provide anything.

6 The other part is --

7 JUDGE KERINS: Counsel, isn't it supporting the hand when you have
8 the dongle at the top? Isn't that supporting the hand?

9 MR. KENNARD: It is support but it is not providing any type of resting
10 effect, which is provided by the lap. The lap is clearly what provides it, and if
11 it is moved to the other place, it is not doing it.

12 The other is if you use the dongle, and I think it is argued that you can
13 move it anywhere, you're going to be -- the way this is structured -- and it
14 would be sitting here and you'd be reaching through here to try to use this
15 under the construction they talk about. This will be the Anson dongle.

16 JUDGE HORNER: So are you interpreting the word "supporting" in
17 your claim to mean some sort of resting on as support rather than supporting,
18 for example, by hanging from?

19 MR. KENNARD: From the second section. We're talking about
20 support for the second section, which is the resting effect, which is here for the
21 wrist. The wrist is sitting here. Your fingers are on the wheel, but the resting
22 effect is there, and you can do this when it happens.

23 JUDGE HORNER: But your claim says the second section for
24 supporting a portion of the operator's body, not a second section adapted to
25 allow the operator's body to rest on that piece. And we're saying there is a

1 difference between supporting and what you're talking about as resting.

2 Is there anything in your spec that defines supporting so that we would
3 narrowly construe it to mean resting on rather than, for example, hanging
4 from?

5 MR. KENNARD: In the spec, we talk about the relieving function. Let
6 me look at the spec now. But that is what it provides on the second section.

7 JUDGE O'NEILL: I see at the very end there is a second embodiment
8 that mentions this thing may be a single structure with a single resting material
9 support, a single structure with multiple resting supports and multiple
10 structures with their own resting support. Page 6 of your spec.

11 MR. KENNARD: That is the resting support we're talking about.

12 Thank you, Your Honor.

13 JUDGE O'NEILL: So you want us to narrowly construe this to that
14 second --

15 MR. KENNARD: The intent of a second section is a resting support.
16 That is what it does. And that is what -- when we say deforming pressure
17 when supporting the hand, it is the resting support it provides. And that is --
18 well, the preamble can't be read, but it is fatigue-relieving. It is that support
19 from sitting there. And this, when you have to do it, it changes when you have
20 to grab the wheel.

21 JUDGE O'NEILL: Where was this argued in the Brief? I see you've
22 cited to the particular lap aspect, but the argument appears to be -- basically,
23 the argument appears to be the little dongle just wouldn't be in use during an
24 emergency situation. You'd grab the steering wheel.

25 MR. KENNARD: If in --

1 JUDGE O'NEILL: It wouldn't perform as set forth in claim 20, the hand
2 grip would not perform as set forth. So I don't even see where all of this
3 resting has even been argued except for right now before us.

4 MR. KENNARD: Your Honor, the resting support, it wasn't argued in
5 the Brief. It was raised now, and during the prosecution, discussion back and
6 forth was the operation of either of the three references, which were Anson,
7 Van Arsdel and Laubach.

8 JUDGE O'NEILL: Well, we're not dealing with method claims; we're
9 dealing with an article claim at least in these two cases before us. Where is
10 use coming in on this? Use is kind of a process.

11 MR. KENNARD: The use you're talking about, the resting support?

12 JUDGE O'NEILL: Well, it looks like your arguments are to the use and
13 the art wouldn't be used. And as Judge Kerins said, in the anticipation arena it
14 either can be expressly disclosed or it is capable of being used in a manner and
15 it would read on the claim. It doesn't have to be used in that manner.

16 MR. KENNARD: And the resting -- and I think as was raised earlier,
17 the dongle -- the capability of the dongle being in and of itself used as resting
18 support, we did not see it doing that. We saw the gripping of it, but its
19 reference talks about the lap being the place where the support is provided.

20 JUDGE O'NEILL: That is what Judge Kerins said, well, as long as it
21 could be capable of doing it, it doesn't necessarily have to expressly state and
22 that is where Judge Kerins talked about it was capable of supporting the hand
23 because that is what we see in the claim is support. We don't see rest.

24 And now you're asking us to interpret this claim in a manner that
25 focuses on a second embodiment that is at the very end of a specification. Is

1 that how you're asking us to interpret this claim now? Where you didn't ask
2 that -- it doesn't appear you asked that in the Brief, and I don't know if you've
3 asked that before the Examiner.

4 MR. KENNARD: That was not raised during prosecution specifically,
5 Your Honor.

6 JUDGE O'NEILL: Okay. So we're supposed to give the claims the
7 broadest reasonable interpretation in light of the specification and not limit it
8 to just one particular embodiment.

9 MR. KENNARD: I understand that, Your Honor.

10 JUDGE O'NEILL: I think that what actually -- when we reviewed the
11 record, what seemed to be really the major issue between you and the
12 Examiner is actually the very last portion of claim 20 that deals with the
13 deformation of -- the deforming out of interference and that you appear to have
14 said, well, even if -- just for argument sake there might be some inherency
15 going on here, we'll prove to you that it cannot do it.

16 And so we would like you to go through each reference and maybe
17 explain to us why there are three 102s and why they are not capable of
18 performing the second section's function. We are assuming the Examiner did
19 make the *prima facie* case of anticipation and invoked the idea of inherency, as
20 such the burden shifts to the Appellant to come up before us or before the
21 Examiner and show that the prior art does not have this inherent feature.

22 And it seemed to be that that inherent feature that the Examiner was
23 relying or pointing to was the deformation out of interference. So what can
24 you say with the three references -- in each reference that would show to us --

1 satisfy us that each of these three references is incapable of performing that
2 functional language of deforming out of interference?

3 MR. KENNARD: Starting with Van Arsdel, that reference when
4 screwed in place does not deform out of interference.

5 And we'll take Anson since that is the last one. If you look at -- again,
6 you go to the Laubach, it has screws that go through the steering wheel and it
7 will not deform out of interference, the use of the dongle deforming out of
8 interference.

9 And when we looked at the reference trying to figure how that would
10 happen is that you're holding -- if you're holding the dongle at the bottom -- I
11 mean, where it is disposed and shown disposed, the grabbing of the wheel
12 would be, we believe, that you'd grab the wheel.

13 I mean, if something happens you grab the wheel. It doesn't show
14 where you would grab over the dongle to try to be -- inherently go out of
15 interference.

16 The dongle is in a place where if you're holding it -- I'm assuming your
17 hands are on top of each other if that is the case, or one hand and you would
18 grab the wheel we would guess somewhere on the side to get control of the
19 car. And we did not see where it would be inherent that that would be moving
20 out of interference.

21 We tried to put it in a position and that is when we tried to argue where
22 it would be in a position to do that. I mean, if you grabbed that, you would be
23 looking for an inherency issue. And that would be if it was at the top because
24 that is where you would be grabbing the wheel as we understand.

1 Because what they talk about in the reference Anson, they talk about
2 you move -- where you normally hold it, you move your hands to the bottom
3 for the resting portion on your lap, and that is why we didn't see where it had
4 the inherent nature of the moving out of interference if you had to grab the
5 thing in an emergency situation.

6 JUDGE O'NEILL: Okay. So what I heard from you with the first two
7 references, you identified some clear structural mechanisms that would --
8 could possibly defeat the inherency position that the Examiner has set forth.

9 And for the Anson reference you've argued its use or how it is used or
10 where it is located, basically. And your position is that the operator would not
11 be using it. He would be grabbing the wheel.

12 MR. KENNARD: We're looking at -- and I understand your question is,
13 is it capable of doing it? And I think you are asking -- this is Judge Kerins
14 said is it capable of doing it. We didn't see it was capable because we tried --
15 in looking at what the reference taught and where the reference teaches you
16 about this dongle, the dongle being -- is disposed below the steering wheel. It
17 is the only place it said dispose of.

18 You can -- again, you can remove it and put it someplace else. And
19 we're trying to figure where that is because they talk about to be able to move
20 and hold the wheel in a driving position, and I assume going straight. I don't
21 know. It would be very difficult to turn. I don't know how they'd do it. But
22 the point is, it is sitting down here in your lap. That is the only disposition we
23 see of it.

1 And the holding of the wheel was never associated with that dongle. At
2 least in the first two mentioned, those being Van Arsdel and Laubach. There is
3 association of the wheel and the unit. In the Van Arsdel, at least you're
4 holding the wheel. In the other, they have the two things which you're
5 holding out here which is associated with the wheel.

6 The third one is the hands are disposed away from the wheel and not
7 associated with it. And the grabbing of the wheel seems to be nowhere
8 associated with that dongle. They talk about moving from the 10:00 and 2:00
9 position down to the bottom.

10 JUDGE HORNER: In an emergency if you were to grab the wheel right
11 around where this dongle is attached to the wheel, wouldn't it deform out of
12 your way just by virtue of the material it is made from?

13 MR. KENNARD: It may.

14 JUDGE O'NEILL: Couldn't -- if you had to do really a hard turn to the
15 left and a hard turn to the right, you would eventually grab hold of it? Say you
16 were making a U-turn or something, you have to turn the wheel once or twice
17 around. Wouldn't it --

18 MR. KENNARD: You mean if you're spinning the wheel around?

19 JUDGE O'NEILL: Not if you're spinning the wheel around but
20 something similar to that, yes. If you're going hand over hand in turning the
21 wheel around, by its materials that it is made out of deform out of interference
22 with your ability to operate the steering wheel when pressure applied?

23 MR. KENNARD: I don't think it is you grabbing it; I think it deforms
24 period. It is -- the material it is made of, you wouldn't deform it; it would just
25 deform. They talk about -- you know, you are moving your hand, they talk

1 about using it, being pliable. If you moved it around, it wouldn't be you
2 deforming it; it would deform by itself.

3 JUDGE O'NEILL: I believe Anson says that the material is pliable
4 and semirigid. So it has some rigidity associated with it. I don't think it just
5 flops around.

6 MR. KENNARD: Well, they say it is a bulbous rubber material and
7 they have -- I think if they -- the way they talk about it used, it will move. It is
8 meant to move.

9 JUDGE KERINS: Counsel, you had given a situation in an emergency
10 you would let go of the dongle and grab the steering wheel. I understand what
11 you're saying there. Suppose you then start turning the wheel and because the
12 dongle is sitting down in the lap portion that the dongle ends up hitting your
13 thigh.

14 Would your body not then be deforming the dongle as you're turning the
15 wheel to deform it out of interference with your thigh?

16 MR. KENNARD: It wouldn't be gripping the wheel. It may move and I
17 think deforming pressure when you're grabbing -- if you're grabbing and
18 deforming pressure on that, it may move to the left or right, say it hits your leg
19 if it is laying down.

20 But it is not moving out of interference with you grabbing the wheel. It
21 moved -- your leg will move it, but that is not moving out of interference so
22 you can grab the wheel.

23 JUDGE KERINS: So it has to be the same body part that is resting at
24 one point and deforming at another part?

1 MR. KENNARD: It is -- the part that we believe is the part that is
2 being -- you're correct. It is so that if you're resting on something, you grab
3 the wheel, you can grab the wheel over that unit so that it will deform out of
4 interference.

5 And that is -- and a good example of this is if you think about the old
6 suicide nobs that used to be on -- that is something that sits out from the wheel.
7 You could rest your hand on that. But if you ever had to grab, that is going to
8 hit.

9 And so the issue, getting back to your specific issue, and that is the
10 hitting your leg. Interference -- your leg is not the one driving the car; it is
11 going to be your hands when you grab it.

12 JUDGE O'NEILL: But your claim just asks for it to be formed out of
13 interference with the vehicle's operator ability to operate a steering wheel.

14 Now, surely, going back to Judge Kerins' hypothetical, it being the inner
15 thigh knocking it out of the way, surely that -- and it deflecting as we kind of
16 all agreed to, I believe, would deform out of interference with the vehicle
17 operator's ability to operate the steering wheel because if it didn't, then you'd
18 have this dongle hit your thigh and you couldn't turn your steering wheel.

19 MR. KENNARD: The -- if it was a stiff dongle? If the dongle was
20 stiff?

21 JUDGE O'NEILL: Right. If it couldn't deform out, if it was a stiff
22 dongle -- and giving Judge Kerins' hypothetical of having to grab it like you
23 said at 10:00 and 2:00 and having to turn the wheel to the left or to the right, it
24 would hit your inner thigh.

1 And if it didn't have any capability of deforming out of interference, it
2 would then preclude the operator to operate the steering wheel because your
3 thigh would block it. You couldn't turn it any farther.

4 MR. KENNARD: The thigh -- take the assumption -- Judge Kerins'
5 assumption you have a stiff -- it is stiff versus pliable.

6 JUDGE O'NEILL: Right.

7 MR. KENNARD: In hitting your leg about deforming out of
8 interference with the wheel, it is, we believe, the hands that are providing
9 being rested would be the ones that should grab the wheel.

10 They are consistent with we have never changed -- this is what is
11 provided and hopefully the claim is clear enough that if this is resting and this
12 is going to bend out of interference of where your hand is resting, the thigh --
13 contacting the thigh would not be, we believe in the context of that claim, out
14 of interference. Because the thigh is not what is operating -- your operating
15 ability of your hands if it is a stiff one, and they didn't talk about having a stiff
16 one.

17 JUDGE O'NEILL: But it just says vehicle operator's ability. Doesn't
18 limit it to hands or body parts. I don't see any limitation of body parts in this
19 claim at all. I just see vehicle operator's ability to operate the steering wheel.

20 That is the key throughout this entire claim portion of the vehicle
21 operator's body. I think there is no limits on having it held in hands. It could
22 be any body part. It appears to be -- what appears to be stated.

23 MR. KENNARD: And the Anson reference, in reviewing it, it didn't
24 talk about that type of structure. It was one to be pliable.

1 JUDGE O'NEILL: But again, I think the issue between you and the
2 Examiner has never been something what the Anson explicitly discloses; it has
3 been what Anson could inherently disclose or is capable of doing. That
4 appears to be the entire issue.

5 And so we are looking for something to -- some evidence to show that
6 Anson is incapable of performing this function in some way or manner, viz.
7 deforming out of interference of the vehicle operator's ability to operate a
8 steering wheel and pressure from the portion of the vehicle operator's body as
9 applied to the second section is equal to or greater than the pressure deforming
10 the second section out of interference with the vehicle operator's ability to
11 operate the steering wheel.

12 MR. KENNARD: The reference -- the support that goes back, and this
13 goes back to if I may talk about Anson again. Anson has an ability. It is
14 flexible and it -- you're right, Judge Kerins. If you turn the wheel and it hits
15 your leg, I assume it is going to be pliable. It is going to move. And I think
16 we all agree it would move. We haven't challenged that from Judge Kerins.

17 The second issue is if we make it a stiff item, and that is the one that I
18 think Judge O'Neill, you're saying, if it is stiff, would that make a difference?
19 If I'm correct.

20 JUDGE O'NEILL: Right.

21 MR. KENNARD: If it is stiff and you turn and it hits your leg, and that
22 would be one which would interfere with your ability to steer the car. Am I
23 correct?

24 JUDGE O'NEILL: Correct.

1 MR. KENNARD: That is what you're saying. So if we look at the
2 pliable version of Anson, then if you turn the wheel and it moves, then that is
3 moving out of interference with -- am I framing that correctly? I just want to
4 make sure.

5 JUDGE O'NEILL: Right. You're framing it correctly.

6 MR. KENNARD: As we see the situation with Anson, it is not just
7 the -- the inherency issue you're talking about goes to not only that one
8 issue, but it also goes to how it is used -- not used but how they describe the
9 structure, its operation in there and the resting portion, which we talked about
10 earlier. I think we have to put it all together. The hands grip the bulb and say
11 it is pliable and the rest is provided by the arms on the lap.

12 And that -- when you do that, that would be holding it, and the
13 inherency issue inherently moving, hitting the leg, is not as we see the same as
14 what we're talking about where we're talking about if the inherent feature of
15 one of the others is it would move if you grabbed it because you're actually
16 associating the unit or the device of the hand.

17 And that is where we see the difference between the two. Because
18 Anson is sitting down below in a location that is different from associating
19 directly with the wheel.

20 JUDGE HORNER: I think we've got your arguments. We're running a
21 little short on time. If you want to just wrap up briefly and then we'll see if
22 there are any more -- do you have another question?

23 JUDGE O'NEILL: He has the 112. Have you gone over the 112?

1 JUDGE HORNER: Do you want to touch on the 112 just briefly? I
2 mean, we've got your arguments from the brief, but if you've got anything you
3 want to add.

4 MR. KENNARD: What we provided with the arguments on the 112
5 issue is -- as I said, we filed this second case, which is the 1568, if I am
6 correct.

7 JUDGE KERINS: 5608.

8 MR. KENNARD: I'm sorry. In that -- when we added --

9 JUDGE KERINS: No, I'm sorry. 1868.

10 JUDGE HORNER: 1868.

11 JUDGE KERINS: I apologize.

12 MR. KENNARD: What we added -- in that reference, what we're
13 talking about rigid, semi-rigid, flexible and deformable. We'll get to that issue.
14 They weren't meant to be common terms used when someone wouldn't
15 understand the art. We provided the dictionary definitions of them.

16 And also the Phillips case which was cited by the Examiner talks about
17 that and says if it is something a layperson would understand what those terms
18 would be, that is sufficient for the descriptive portion of the claim.

19 We're not trying to say it is anything other than what a dictionary
20 definition of those terms would be. He cited the 1969 case which says flexible
21 is ambiguous, and the Examiner cited it in his art. But we believe that in the
22 context of what we described, the dictionary definitions do describe what this
23 material is.

24 JUDGE O'NEILL: So you're basically -- you agree that your
25 specification provides no explicit definition for these terms?

1 MR. KENNARD: No.

2 JUDGE O'NEILL: You don't have to say when we say rigid we mean
3 this. That is an explicit definition.

4 MR. KENNARD: We did not say that.

5 JUDGE O'NEILL: You don't have that. And the words -- none of the
6 words around these terms are going to kind of help us construe this language
7 meaning? It is just -- you're just asking us to rely basically on the plain
8 meaning found in -- that one of ordinary skill in the art -- that is what
9 one of ordinary skill in the art would understand that these terms mean.

10 MR. KENNARD: Yes, Your Honor. In the argument by the Examiner
11 back to us, it was, you know -- it started out what was a Rockwell number for
12 the material and in which -- if it was a metal I could see what the Rockwell
13 number would be. And then he changed a couple of times what he had in his
14 argument and then came back with what is the objective test in the final
15 iteration of the Answer about objective tests and cited the Phillips.

16 But what we're citing to is it is the common understanding what you
17 would know as semirigid. If you look at the dictionary definitions, one of
18 ordinary skill or a layman would understand what those would be from the use
19 in the specification.

20 JUDGE KERINS: Counsel, this wasn't raised by the Examiner and we
21 originally approached it from the language about non-deformable and how can
22 it be non-deformable yet be deformable. Apparently you've said you'll try to
23 fix that up in further prosecution. How about the word "rigid" though? If we
24 have something that is rigid, how is it going to deform?

1 MR. KENNARD: It can deform. It can deform and I think we talk
2 about this. This is the material here can be rigid. This is the second section.
3 If at the first -- and we talk about the first section, this can be rigid and still
4 bend down. You can still grab it. It is not going to fall all the way around, but
5 you can still grab it in an emergency. And that is what we were getting to
6 there.

7 And because we didn't want from the first application -- that is the
8 5608?

9 JUDGE KERINS: Yes.

10 MR. KENNARD: I got it finally. That Mr. Wilson wanted to share that
11 it could be other materials, explicitly other materials, and that being -- this
12 could be rigid and it could be semi-rigid and it could be flexible, and that is
13 where --

14 JUDGE KERINS: Counsel, this may not have an ultimate effect, but
15 does that exclude anything -- rigid, flexible and semi-rigid? Is there anything
16 excluded by reciting that that way?

17 MR. KENNARD: I haven't looked at it that specifically, and I would
18 have to take that under advisement if it excludes anything, but he wanted to
19 cover that it could be of other mixture. That it would be understood by
20 someone reading it of the two patents that that would be -- or two applications
21 that it could be of different materials.

22 And also it goes and explains within the second application the
23 flexibility can be -- at the juncture in there if you read through the specification
24 it talks about that, so that would apply.

25 JUDGE KERINS: Fair enough.

1 JUDGE HORNER: Any further questions?

2 JUDGE KERINS: Nothing more.

3 JUDGE HORNER: Thank you for your time.

4 MR. KENNARD: I'd like to thank you for your time and effort and
5 letting me take some informalities of sitting down which is not normal in a
6 courtroom.

7
8 (Whereupon, the proceedings at 2:26 p.m. were concluded.)